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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/219,121	12/23/1998	HIROSHI TANAKA	2091-0182P-S	2219

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EXAMINER
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HANNETT, JAMES M

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/219,121	<b>Applicant(s)</b> TANAKA, HIROSHI	
	<b>Examiner</b> James M. Hannett	<b>Art Unit</b> 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-7, 9-14 and 17-23 is/are rejected.  
 7) ☒ Claim(s) 8, 15 and 16 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 23 December 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:  
 1. ☒ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 4/13/2005 have been fully considered but they are not persuasive. The applicant argues that it is unreasonable for the examiner to view the negative film scanner (10) as being equivalent to the digital camera as claimed.

The examiner disagrees with the applicant. Nakazawa et al depicts in Figure 2 a system that captures images using a CCD image sensor and outputs electronic signals representing a captured image to an A/D converter (150) to be digitized into digital image data. This system is clearly equivalent to a digital camera and the fact that the camera is digitizing an image already captured on film does not take away from the fact that the system produces digital image data from an optical representation of an object.

The applicant has amended the claims to state that; the digital camera has the capability to take an image of a real object. The examiner views the image captured on the film (110) as being an image of a real object. The fact that the image is already captured on film before digitized by the digital scanner does not lead the examiner to believe that the image is not an image of a real object.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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**1:** Claims 1-5, 9 and 19-23 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,331,903 Nakazawa et al.

**2:** Referring to claim 1, Nakazawa discloses an order processing method used in an image output service comprising the steps of obtaining image data by photographing image data using a CCD 13 in figure 8 and storing all picture data for the photographed frames in the recording medium 60. The obtained image data is displayed on the display medium 30 for the user to preview the image. The user using the control key section 50 provides output instructions for the image data. Order information describing the output instructions are generated in a predetermined data format and stored in the recording medium 60 along with the corresponding image data. Nakazawa discloses that the monitor section 30 can display the index picture consisting of a plural of frames of image data along with the instructed order information. An order is certified by the user by recording confirmed order information in the recording medium 60 when a predetermined order confirmation operation is performed by the user operating the control key 50 indicating that the user has confirmed the content of the output instructions by watching the display of the display medium 30. When the order and order confirmations completed, the CPU 70 outputs the order information to the printer 24 by which the image data is printed in accordance with the confirmed order information (Col. 8, Line 4 - Col. 9, Line 55). The examiner points out that the system as discussed in Nakazawa is viewed as a digital camera system because the CCD (13) captures images and outputs a digitized image. Therefore, it is viewed by the examiner that the steps of obtaining the image data, replaying the image data, receiving the output instructions, generating the order information, displaying on the displaying medium all image data output, and certifying the order are carried out in the digital camera.

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3: Referring to claim 2, Nakazawa discloses an order processing system used in an image output service comprising the means of obtaining image data by photographing image data using a CCD 13 in figure 8 and storing all picture data for the photographed frames in the recording medium 60. The obtained image data is displayed on the display medium 30 for the user to preview the image. The user using the control key section 50 provides output instructions for the image data. Order information describing the output instructions are generated in a predetermined data format and stored in the recording medium 60 along with the corresponding image data. Nakazawa discloses that the monitor section 30 can display the index picture consisting of plurality of frames of image data along with the instructed order information. An order is certified by the user by recording confirmed order information in the recording medium 60 when a predetermined order confirmation operation is performed by the user operating the control key 50 indicating that the user has confirmed the content of the output instructions by watching the display of the display medium 30. When the order and order confirmations completed, the CPU 70 outputs the order information to the printer 24 by which the image data is printed in accordance with the confirmed order information (Col. 8, Line 4 - Col. 9, Line 55). The examiner points out that the system as discussed in Nakazawa is viewed as a digital camera system because the CCD (13) captures images and outputs a digitized image. Therefore, it is viewed by the examiner that the data obtaining means, the instruction receiving means, the order information recording means, the order content confirming means, and the order certifying means are provided in a digital camera.

4: Referring to claim 3, Nakazawa discloses an order processing apparatus used in an image output service comprising the means for obtaining image data by photographing image data

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using a CCD 13 in figure 8 and storing all picture data for the photographed frames in the recording medium 60. The obtained image data is displayed on the display medium 30 for the user to preview the image. The user using the control key section 50 provides output instructions for the image data. Order information describing the output instructions are generated in a predetermined data format and stored in the recording medium 60 along with the corresponding image data. Nakazawa discloses that the monitor 30 can display the index picture consisting of plural frames of image data along with the instructed order information. An order is certified by the user by recording confirmed order information in the recording medium 60 when a predetermined order confirmation operation is performed by the user operating the control key 50 indicating that the user has confirmed the content of the output instructions by watching the display of the display medium 30. When the order and order confirmations completed, the CPU 70 outputs the order information to the printer 24 by which the image data is printed in accordance with the confirmed order information (Col. 8, Line 4 - Col. 9, Line 55). The examiner points out that the system as discussed in Nakazawa is viewed as a digital camera system because the CCD (13) captures images and outputs a digitized image. Therefore, it is viewed by the examiner that the data obtaining means, the display means, the instruction receiving means, the order information recording means, the order content confirming means, and the order certifying means are provided in a digital camera.

5: Referring to claim 4, Nakazawa discloses an order receiving apparatus in figure 7 which receives an order for an image output service by obtaining order information in a digital format, the order receiving apparatus comprises: data reading means for reading the order information input by the user using the control keys 50 describing an output instruction regarding image data

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from a recording medium 60, confirmed information certifying means is provided for the print order information input by the user using control keys 50 and then confirmed by the user where the certifying means records the confirmed order information in the recording medium 60, and output instructing means is provided by CPU 70 for instructing, based on the order information recorded in the recording medium, output of the image data to the printer 24 when the confirmed order information is recorded in the recording medium 60 (Col. 8, Line 4, Col. 9, Line 55).

The examiner points out that the system as discussed in Nakazawa is viewed as a digital camera system because the CCD (13) captures images and outputs a digitized image.

6: Referring to claim 5, Nakazawa discloses a digital camera comprising an order processing apparatus comprising the means for obtaining image data by photographing image data using a CCD 13 in figure 8 and storing all picture data for the photographed frames in the recording medium 60. The obtained image data is displayed on the display medium 30 for the user to preview the image. The user using the control key section 50 provides output instructions for the image data. Order information describing the output instructions are generated in a predetermined data format and stored in the recording medium 60 along with the corresponding image data. Nakazawa discloses that the monitor section 30 can display the index picture consisting of plural frames of image data along with the instructed order information. An order is certified by the user by recording confirmed order information in the recording medium 60 when a predetermined order confirmation operation is performed by the user operating the control key 50 indicating that the user has confirmed the content of the output instructions by watching the display of the display medium 30. When the order and order confirmations completed, the CPU 70 outputs the order information to the printer 24 by which the image data is printed in

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accordance with the confirmed order information (Col. 8, Line 4-Col. 9, Line 55). The examiner points out that the system as discussed in Nakazawa is viewed as a digital camera system because the CCD (13) captures images and outputs a digitized image. Therefore, it is viewed by the examiner that the photographing means, the image recording means, the display means, the instruction receiving means, the order information recording means, the order content confirming means, and the order certifying means are provided in the digital camera.

7: Referring to Claim 9, Nakazawa discloses that the order information generating function records the order information in the recording means as an order file (col. 9, Lines 22-29).

8: As for Claim 19, Nakazawa teaches in the abstract that the digital camera (system depicted in Figure 1) is capable of taking an image of a real object (the information recorded on the film (11) is viewed as an image of a real object), and wherein the display medium (200) is capable of displaying the image of the real object when the image is taken and during order processing.

9: In regards to Claim 20, Nakazawa teaches in the abstract that the digital camera (system depicted in Figure 1) is capable of taking an image of a real object (the information recorded on the film (11) is viewed as an image of a real object), and wherein the display medium (200) is capable of displaying the image of the real object when the image is taken and during order processing.

10: As for Claim 21, Nakazawa teaches in the abstract that the digital camera (system depicted in Figure 1) is capable of taking an image of a real object (the information recorded on the film (11) is viewed as an image of a real object), and wherein the display medium (200) is



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capable of displaying the image of the real object when the image is taken and during order processing.

11: In regards to Claim 22, Nakazawa teaches in the abstract that the digital camera (system depicted in Figure 1) is capable of taking an image of a real object (the information recorded on the film (11) is viewed as an image of a real object), and wherein the display medium (200) is capable of displaying the image of the real object when the image is taken and during order processing.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12: Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,331,903 Nakazawa et al in view of USPN 5,737,491 Allen et al.

13: Referring to claim 6, Nakazawa fails to disclose a specific method deleting image data from the recording medium 60 canceling the order confirmation option. Allen discloses a verbal command "Erase" listed in Table 1 (Col. 3, Line 55 - Col. 4, Line 13) that deletes an image file, including the header tile of the image data containing the print order instructions thereby canceling the order, when input to the voice recognition module 30 by the user.

Therefore it would have been obvious to provide the order cancel feature of Allen with the print order system of Nakazawa so that the user has the ability to override the print operation

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even after confirming the order so as to prevent any unnecessary or unwanted printing of the image data.

14: Referring to claim 7, Allen discloses a verbal command "Erase" listed in Table 1 (Col. 3, Line 55 - Col. 4, Line 13) that deletes an image file, including the header file of the image data containing the print order instructions thereby canceling the order, when input to the voice recognition module 30 by the user. If the user captures one image to memory and generates order instructions for that image, then deletes that image file, the user is deleting all image data that output of which has been instructed along with the order information stored in the image header file.

15: Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,331,903 Nakazawa et al in view of USPN 6,381,582 Walker et al.

16: Referring to Claim 10, Nakazawa does not disclose that the order certifying means records data in addition to the order information data in the recording medium such as a valid date. However, storing an order confirmation date is well known as taught by Walker. Along with an order confirmation code 48 in figure 2B, Walker also records an order date 54 representing the date at which payment for the order has been received (Col. 6, Lines 33 - 46).

Storing an order date as another confirmation code is useful as a means to provide confirmation to the user and the merchant that payment has been received to avoid any billing disputes. Therefore it would have been obvious to store a confirmation date with the order information of Nakazawa so as to provide proof of payment to the user and the image fulfillment center.

17: Referring to claim 11, Nakazawa does not disclose that the order certifying means records data in addition to the order information data in the recording medium such as code. However, Walker discloses a method of capturing electronic order information and generating an order code otherwise known as an order confirmation number or purchase number, when the user confirms an order by transmitting it to an order fulfillment center. The order confirmation number of Walker is sent to the user as confirmation that the order has been received and is stored along with the order, as shown in figure 2B, as a unique identifier allowing the user to track an order by presenting the tracking number to the merchant (Col. 6, Lines 33 - 46 and Col. 10, Lines 15 - 24).

Therefore it would have been obvious to use the confirmation order number of Walker with the camera/printer system of Nakazawa so the user can receive confirmation from the fulfillment center that the order has been received and so that orders may be tracked to ensure they are completed, on time and correctly.

18: Referring to claim 12, Nakazawa discloses an image recording means for recording each image as an image file in the recording medium 60, the order information recording means records the order information as accompanying information included in the image file, and the order certifying means certifies an order when the user confirms the order information (Col. 8, Line 4 - Col. 9, Line 55). Nakazawa does not disclose that the order certifying means records data in addition to the order information data in the recording medium such as code.

However, Walker discloses a method of capturing electronic order information and generating an order code otherwise known as an order confirmation number or purchase number, when the user confirms an order by transmitting it to an order fulfillment center. The order

confirmation number of Walker is sent to the user as confirmation that the order has been received and is stored along with the order, as shown in figure 2B, as a unique identifier allowing the user to track an order by presenting the tracking number to the merchant (Col. 6, Lines 33 - 46 and Col. 10, Lines 15 - 24).

Therefore it would have been obvious to use the confirmation order number of Walker with the camera/printer system of Nakazawa so the user can receive confirmation from the fulfillment center that the order has been received and so that orders may be tracked to ensure they are completed, on time and correctly.

**19:** Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,331,903 Nakazawa et al in view of USPN 5,983,200 Slotznick.

**20:** Referring to claim 13, Nakazawa discloses an electronic order system that allows a user input and confirm print orders and to submit the electronic confirmed print orders to a fulfillment center. Nakazawa does not specifically disclose an urging means for carrying out a display prompting an order confirmation. However, Slotznick discloses an electronic order system with a graphic interface comprising an order confirmation means. Figures 4, 6 and 7 of Slotznick show an order screen where a user selects details of the items being ordered, shipping information, billing information, etc. In the bottom middle portion of the order window, an urging means is provided and labeled, "save This Order", prompting the user to confirm the order information input on the order screen.

Therefore it would have been obvious to display an urging means as shown by Slotznick on the camera display of the camera/printer system of Nakazawa to remind the user to confirm their order thereby properly storing it in the recording medium.

21: Referring to claim 14, Referring to claim 14, Slotznick discloses a display message in Figures 6 and 7 urging the user to confirm order information output on a display monitor.

22: Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,331,903 Nakazawa et al in view of USPN 5,440,343 Parulski et al in further view of USPN 6,529,236 Watanabe.

23: Referring to claim 17, Nakazawa fails to teach or suggest a recording mode means for enabling a selection of a printing mode wherein in the printing mode the photographing means is set at maximum resolution.

Parulski discloses that it is well known to provide a photographing means having multiple modes of image capture. The camera system as shown in figure 1 of Parulski comprises a mode select 20 on the operator control unit allowing the user to toggle the operation of the photographing means between a low resolution mode of image capture where the object image is captured in standard NTSC format and a high resolution mode of image capture where pixel signals of the entire pixel sensor are used to pick up a quality still image (Col. 2, Lines 1 - 31).

Therefore it would have been obvious to provide the resolution modes of Parulski with the image capture system of Nakazawa so that the user may capture a moving image or high quality still image.

Parulski does not disclose that the high-resolution still mode is a print mode. However, Watanabe discloses that it is well known to provide a printing means for producing hard copies of captured still images. In addition Watanabe also discloses that when capturing an image for printing, it is ideal that the captured image be high resolution (Col. 1, Lines 28 - 44 and Col. 16, Lines 23 - 50).

Therefore it would have been obvious to one of ordinary skill in the art as taught by Wantanabe, to use the high resolution mode of Parulski as a printing mode so that the user captures images in the best quality when it is intended that they be reproduced by printing means and that the normal resolution mode of Parulski be designated as the non-printing mode because as taught by Wantanabe, the user would desire a high resolution in a image if it is being printed.

24: Referring to claim 18, Panzlski discloses a non printing mode of image capture where moving images are captured in a low resolution NTSC format (Col. 2, Lines 1 - 31). Parulski also discloses an alternative embodiment where an HTDV image sensor is used to obtain the still images for the print mode and the motion images of the non-print mode. According to Parulski, motion images could be provided by selecting high quality non-compressed HTDV format or low resolution NTSC format by using a down-conversion compressing the HDTV signal to a standard definition format (Col. 1, Lines 43 - 54).

***Allowable Subject Matter***

25: Claims 8, 15 And 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Referring to claim 8, the prior art fails to show a certifying means that certifies an order by setting a hidden property of the order file to visible.

Referring to claim 15, the prior art fails to show displaying the operation urging message for a predetermined period after an operation to switch off the power to the digital camera, then switches the power off after the predetermined period of time elapses.

Referring to Claim 16, the prior art fails to show an operation urging means carrying out the display of the order confirmation prompt when the recording medium is pulled out from the body of the digital camera.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

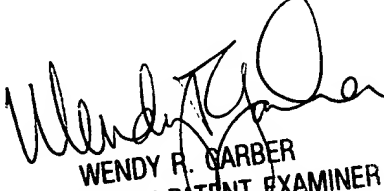
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hannett whose telephone number is 571-272-7309. The examiner can normally be reached on 8:00 am to 5:00 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 571-272-7308. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James M. Hannett  
Examiner  
Art Unit 2612

JMH  
June 20, 2005

  
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SUPERVISORY PATENT EXAMINER  
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